

### REMARKS

The claims stand rejected under 35 U.S.C. §102(b). Applicant has amended Claim 1, in an effort to obviate the rejection. In view of the Amendment and the following remarks, withdrawal of the rejection is respectfully requested.

### REJECTION OF CLAIMS FOR ALLEGED ON-SALE BAR

The information about the lawsuit between Con-Way and Regscan, to which the Patent Office refers, is incomplete in a number of respects. The Office Action puts forth no explanation of the structure of the Hazcalc product. The Office Action also fails to apply the claims to the HazCalc product. Perhaps the most significant deficiency in the Office Action is that the Office Action makes fact findings that are unsupported by evidence, and (even if the claims cover the HazCalc product), the activities upon which the Office Action relies to assert an "on-sale bar" , as a matter of law, do not constitute a violation of 35 U.S.C. §102(b). *Pfaff v. Wells Elecs., Inc.*, 48 USPQ2d 1641 (1998).

As discussed in the information disclosure statement, included herein, the HazCalc product was initially disclosed to Regscan in a non-public manner, and subject to confidentiality. A written confidentiality agreement existed between the parties, leading up to and through negotiation of the May 3, 2000 Licensing Agreement.

Further, at the time of the initial disclosure, and during the negotiations of the May 3, 2000 Licensing Agreement, the HazCalc product was still in a state of development, and was being tested internally by Con-Way at a Con-Way facility in Iowa to assure that it worked for its intended purpose in its intended environment. Access to that facility (and the HazCalc product) was within the control of Con-Way, was restricted and not available to the general public.

The Court of Appeals for the Federal Circuit has made clear that the activities pre-critical date activities upon which the Examiner relies are not in contravention of 35 U.S.C. §102(b). See e.g., *Elan Corp. PLC v. Andrx Pharmaceuticals Inc.*, 70 U.S.P.Q.2d 1722, 1726 (Fed. Cir. 2004)("An offer to enter into a license under a patent for future sale of the invention covered by the patent when and if it has been developed, which is what the Lederle letter was, is not an offer to sell the patented invention that constitutes an on-sale bar"); *In re Kollar*, 62 U.S.P.Q.2d 1425, 1429 (Fed. Cir. 2002)("The proper reading of *Mas-Hamilton*, therefore, is that the offer of a license under a patent and a description of the invention, without more, does not

fall within the on-sale bar of §102(b)"); see also, *Mas-Hamilton Group Inc. v. LaGard Inc.*, 48 USPQ2d 1010, 1019 (Fed. Cir. 1998) ("The district court found that Mosler was only a potential licensee. Cf. *Moleculon Research Corp. v. CBS, Inc.*, 793 F.2d 1261, 1267, 229 USPQ 805, 809 (Fed.Cir. 1986) (holding that '[a]n assignment or sale of rights in the invention and potential patent rights is not a sale of the invention within the meaning of section 102(b)')").

Moreover, the experimental use negation of the on-sale bar precludes application of the on-sale bar to the present facts. See, e.g., *Honeywell International Inc. v. Universal Avionics Systems Corp.*, 488 F.3d 982, 82 U.S.P.Q.2d 1886 (Fed. Cir. 2007).

Accordingly, the findings of the Examiner are not supported by evidence.<sup>1</sup> Further, the facts are such that the Examiner's rejection is contrary to law. Therefore, withdrawal of the rejection is respectfully requested.

#### REJECTION UNDER SECTION 102(b) MORELL

Applicant disagrees with the Office Action. However, in the interest of advancing prosecution, Applicant has amended Claim 1. In view of the amendments to claim 1, Morell is no longer believed to be applicable. Morell simply does not teach a processor that functions as claimed. There is not teaching or suggestion in Morell of a processor that "selects the determinable one of the plurality of placards in response to the input arrangement, the classifications memory, the exceptions memory, and the general rules memory".

#### INFORMATION DISCLOSURE STATEMENT

The HazCalc product that is the subject of decision (see attached) on July 6, 2007 by the Court of Appeals for the Third Circuit in Case Nos. 06-2262 and 06-2384 was initially disclosed to Regscan in a non-public manner, and subject to confidentiality. A written confidentiality agreement existed between the parties, leading up to and through negotiation of the May 3, 2000 Licensing Agreement. Further, even if the pending claims read on the subject of HazCalc at the time of the initial disclosure, and during the negotiations of the May 3, 2000

---

<sup>1</sup> The findings and evidence set forth by the Court in the attached decision do not support the Examiner's position, and instead refutes it. It cannot be seen how the Examiner can rely upon the Court decision and assert that the subject of HazCalc was "ready for patenting" in the face of quotes of the Court that HazCalc allegedly was "a rather incompetent program" (see page 5).

Licensing Agreement, the HazCalc product was still in a state of development, and was being tested internally by Con-Way at a Con-Way facility in Iowa to assure that it worked for its intended purpose in its intended environment. Access to that facility and the HazCalc product was restricted, was under the control of Con-Way, and not available to the general public.

Applicants submit this statement in accordance with their duty of disclosure under 37 CFR 1.56 and 1.97-1.98. The submission made herewith is in no way intended as an admission that the cited items constitute material prior art or otherwise would render the claims unpatentable in any way. The submission also is in no way intended to substitute for the Examiner's own independent investigation.

Form PTO/SB/08A is submitted herewith with the cited items. Applicants respectfully solicit the Examiner's consideration of the cited references and entry thereof into the record of this application.

Please charge Deposit Account No. 50-1097 in the amount of \$180.00 for the fee associated with the filing of this Information Disclosure Statement.

#### PETITION FOR EXTENSION OF TIME

Applicants respectfully request and petition an appropriate extension of time to respond to the outstanding Office Action, of at least two (2) months. Enclosed is a check in the amount of \$460.00. For any deficiencies, please charge Deposit Account No. 50-1097 for any fee which may be due is hereby given.

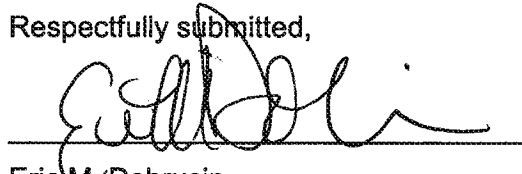
#### CONCLUSIONS

In view of Applicants' amendments and remarks, the Examiner's rejections are believed to be rendered moot. Accordingly, Applicants submit that the present application is in condition for allowance and requests that the Examiner pass the case to issue at the earliest convenience. Should the Examiner have any question or wish to further discuss this application, Applicant requests that the Examiner contact the undersigned at (248) 292-2920.

If for some reason Applicant has not requested a sufficient extension and/or have not paid a sufficient fee for this response and/or for the extension necessary to prevent the abandonment of this application, please consider this as a request for an extension for the required time period and/or authorization to charge our Deposit Account No. 50-1097 for any fee which may be due.

Dated: July 22, 2008

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Eric M. Dobrusin", written over a horizontal line.

Eric M. Dobrusin  
Registration No. 33,867  
DOBRUSIN & THENNISCH PC  
29 W. Lawrence Street  
Suite 210  
Pontiac, MI 48342  
(248) 292-2920

Customer No. 25215

|  |                        |                   |
|--|------------------------|-------------------|
| <b>INFORMATION DISCLOSURE<br/>STATEMENT BY APPLICANT</b><br>(Not for submission under 37 CFR 1.99) | Application Number     | 10/722,642        |
|  | Filing Date            | November 26, 2003 |
|  | First Named Inventor   | Petrancosta       |
|  | Art Unit               | 3653              |
|  | Examiner Name          | Hageman, M.       |
|  | Attorney Docket Number | 1359-008D1        |

| U.S. PATENTS       |          |               |           |            |   |
|--------------------|----------|---------------|-----------|------------|---|
| Examiner Initials* | Cite No. | Patent Number | Kind Code | Issue Date | Name of Patentee of Applicant of cited Document |
|                    | 1.       | 6,688,475     |           | 2.10.2004  | Petrancosta                                     |
|                    | 2.       | 5,822,716     |           | 10.2008    | Morell et al.                                   |
|                    | 3.       | 4,827,395     |           | 5.1989     | Anders et al.                                   |
|                    | 4.       | 4,716,536     |           | 12.1987    | Blanchard                                       |

| U.S. PATENT APPLICATION PUBLICATIONS |          |                    |           |                  |   |
|--------------------------------------|----------|--------------------|-----------|------------------|---|
| Examiner Initials*                   | Cite No. | Publication Number | Kind Code | Publication Date | Name of Patentee or Applicant of cited Document |
|                                      | 1.       |                    |           |                  |   |
|                                      | 2.       |                    |           |                  |   |
|                                      | 3.       |                    |           |                  |   |

| FOREIGN PATENT DOCUMENTS |          |                         |              |           |                  |   |                |
|--------------------------|----------|-------------------------|--------------|-----------|------------------|---|----------------|
| Examiner Initial*        | Cite No. | Foreign Document Number | Country Code | Kind Code | Publication Date | Name of Patentee or Applicant of cited Document | T <sup>5</sup> |
|                          | 1.       |                         |              |           |                  |   |                |
|                          | 2.       |                         |              |           |                  |   |                |
|                          | 3.       |                         |              |           |                  |   |                |
|                          | 4.       |                         |              |           |                  |   |                |

| NON-PATENT LITERATURE DOCUMENTS |          |  |                |
|---------------------------------|----------|--|----------------|
| Examiner Initial*               | Cite No. | Include name of the author (in CAPITAL LETTERS), title of the article (when appropriate), title of the item (book, magazine, journal, serial, symposium, catalog, etc), date, page(s), volume-issue number(s), publisher, city and/or country where published. | T <sup>5</sup> |
|                                 | 1.       | HazCalc Development Information  |                |
|                                 | 2.       |  |                |

| EXAMINER SIGNATURE   |  |                 |  |
|--|--|-----------------|--|
| Examiner Signature   |  | Date Considered |  |
| <b>*EXAMINER:</b> Initial if reference considered, whether or not citation is in conformance with MPEP 609. Draw line through a citation if not in conformance and not considered. Include copy of this form with next communication to applicant. |  |                 |  |